


PRE-APPEAL BRIEF REQUEST FOR REVIEW (filed with the Notice of Appeal)		Docket Number 042933/299757
Application Number 09/967,070	Filed September 28, 2001	
First Named Inventor Russell Pond		
Art Unit 2617	Examiner Stephen, Emem O.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p style="text-align: right;">Respectfully submitted,  Chad L. Thorson Registration No. 55,675</p> <p>Date <u>March 27, 2008</u></p> <p>Customer No. 00826 ALSTON & BIRD LLP Bank of America Plaza 101 South Tryon Street, Suite 4000 Charlotte, NC 28280-4000 Tel Charlotte Office (704) 444-1000 Fax Charlotte Office (704) 444-1111</p> <div style="border: 1px solid black; padding: 5px; margin-top: 20px;"><p>ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON March 27, 2008.</p></div>		

Attachment
Reasons for Requesting Pre-Appeal Brief Request for Review

Claims 1-10, 15 and 16

Claims 1-10, 15 and 16 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baker et al. (U.S. Patent No. 6,507,735, hereinafter “Baker”) in view of Akahane (U.S. Patent No. 5.881.104).

As an initial matter, Applicant respectfully notes that Baker and Akahane are each related to conventional voice mail and not SVMS messages as recited in the claimed invention. Moreover, Applicant has previously defined that the SVMS message is defined as a message including packetized voice data configured to be deliverable to a plurality of recipients as a result of a single transmission from the originating station in each of independent claims 1 and 10. Thus, given the deficiency of Baker and Akahane with regard to any disclosure of operations with respect to an SVMS message as defined in independent claims 1 and 10, the combination of Baker and Akahane fails to teach or suggest any of the recited operations with respect to an SVMS message which is defined as a message including packetized voice data configured to be deliverable to a plurality of recipients as a result of a single transmission from the originating station.

Of note, the final Office Action asserts that the above recited feature is disclosed in Akahane at col. 6, line 40 to col. 7, line 21. Meanwhile, the Advisory Action asserts that a message sent from a terminal of FIG. 1 of Akahane is not limited to one recipient. More specifically, the final Office Action asserts that “communication of a messages from a first station is not limited to only one recipient, therefore, communication of a messages to a plurality of recipient is inherent”. Applicant respectfully disagrees with this analysis. In this regard, in order to establish inherency, “extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In the present situation, it cannot be fairly asserted that if Akahane fails to state that the voice messages only go to one recipient, it necessarily means that the voice messages may be

delivered to a plurality of recipients as a result of a single transmission from the originating station, as provided in the claimed invention. To the contrary, conventional voice messages are well known by those of skill in the art (and even lay persons) to be provided directly from one individual to another individual. As such, any assertion that a lack of mentioning that the voice messages of Akahane are limited to reception by only one recipient could, at best, be considered to leave open the possibility that the messages may be received by more than one recipient. However, as indicated above, inherency is not established based on possibilities. Moreover, Akahane only discloses communicating such messages from one terminal to one other terminal, without any suggestion that one message could be provided from one terminal to a plurality of other terminals.

Furthermore, as stated in MPEP 2112 citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” In the present situation, not only is the recited feature not inherent in the disclosure of Akahane, but the Examiner has also failed to provide any basis in fact or technical reasoning to support such a determination as required by the MPEP citing the patent laws. Since Akahane and Baker individually fail to teach or suggest the above recited feature, any combination of these references also fails to teach or suggest the above recited feature. Furthermore, since none of Akahane and Baker are related to SVMS messages, the recited operations performed with respect to SVMS messages are also neither taught nor suggested by Akahane and Baker either alone or in combination. Dependent claims 2-9, 15 and 16 depend either directly or indirectly from independent claims 1 and 10, respectively, and thus include all the recitations of their respective independent claims. Dependent claims 2-9, 15 and 16 are therefore patentable over Akahane and Baker, either alone or in combination, for at least the same reasons given above with respect to independent claims 1 and 10.

Accordingly, for all the reasons above, the rejections of independent claims 1-10, 15 and 16 should be reversed.

Claims 10-12 and 17-19

Claims 10 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baker in view of Ayoub et al. (International Patent Application No. WO 99/41922, referred to in

the Office Action as “Souhad” and hereinafter “Ayoub”) and further in view of Parvulescu et al. (U.S. Patent No. 5,724,410, hereinafter “Parvulescu”). Claims 11, 12, 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Baker, Ayoub and Parvulescu and further in view of Smith et al. (U.S. Patent No. 6,891,811, hereinafter “Smith”).

Ayoub is directed to a method for broadcast transmission of short voice messages. Thus, Ayoub is the only one of any of the currently cited references that arguably lies in the same field as the claimed invention. However, Ayoub does not perform each of the operations recited in the claimed invention with regard to SVMS messages and is also not cited as such. Thus, various ones of Baker, Parvulescu and Smith are cited in connection with the various operations recited by the claimed invention. One particular such operation relates to determining whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message. Such feature is set forth in each of independent claims 10 and 19 and is neither taught nor suggested by the cited references, either alone or in combination.

Notably, the final Office Action admits, and Applicant agrees, that Ayoub fails to teach or suggest determining whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message. Applicant further asserts that Smith also fails to teach or suggest this feature and are not cited as such. In order to cure the deficiencies of the other cited references, the final Office Action cites Parvulescu as disclosing the above recited feature in the abstract and at col. 2, lines 10-48. However, the cited passages of Parvulescu only relate to determining whether a receiving terminal is capable of reproducing a voice message. As such, Parvulescu does not relate to the ability of the receiving terminal to actually receive the message, but instead relates to whether the receiving terminal can render the message (i.e., whether the receiving terminal has an audio reproducing unit 32 capable of reproducing the voice message). Thus, Parvulescu completely ignores any determination with regard to whether the receiving terminal can receive the message (in this case a particular type of message in the form of an SVMS message), but instead focuses on determining whether the receiving terminal has, for example, a speaker and other hardware or software to support playing a voice message. A determination with regard to whether a device can receive a particular type of message is clearly quite different from a determination as to whether a device can reproduce audio. In this regard, a message could clearly be capable of reception independent of whether the message is capable of reproduction. Accordingly, Parvulescu’s determination with regard to whether the receiving

terminal can reproduce a conventional voice message is unrelated to, and neither taught nor suggestive of, determining whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message as recited in independent claims 10 and 19.

The Advisory Action also asserts that Baker discloses the preceding underlined feature at col. 3, lines 1-24. However, the cited passage of Baker only relates to a mobile switching center that tracks the status of a wireless unit. When the wireless unit is unavailable, the calling party is transferred to a mechanism for recording a short message that can later be delivered to the wireless unit. Thus, as indicated above, Baker is unrelated to SVMS messages as defined in the claimed invention (i.e., a message including packetized voice data configured to be deliverable to a plurality of recipients as a result of a single transmission from the originating station).

Accordingly, Baker necessarily fails to teach or suggest any determination with regard to whether an intended recipient is capable of receiving an SVMS message that is deliverable to a plurality of recipients as a result of a single transmission from an originating station. Thus, even if Baker is assumed to disclose determining whether an intended recipient is available to receive a short message, Baker is still unconcerned with determining whether the intended recipient is capable of receiving an SVMS message prior to transmission of the SVMS message as provided in independent claims 10 and 19. Moreover, combining Baker with any of the other references also fails in this regard since none of the other references are concerned with determining whether an intended recipient is capable of receiving an SVMS as defined in the claimed invention either.

Since none of the cited references teach or suggest determining whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message as recited in independent claims 10 and 19, any combination of the cited references also fails to teach or suggest the above recited features of independent claims 10 and 19. Independent claims 10 and 19, and by dependency claims 11, 12, 17 and 18, are therefore patentable over the cited references taken either alone or in combination.

Accordingly, for the reasons indicated above, the rejections of independent claims 10-12 and 17-19 should be reversed.

Claims 20 and 21

Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ayoub and

Parvulescu and claim 21 currently stands rejected under 35 U.S.C. §103(a) as being unpatentable over Akahane in view of Parvulescu.

As indicated above, neither Akahane nor Parvulescu relates to SVMS messages as defined in independent claim 21. Furthermore, neither Akahane nor Parvulescu teach or suggest a determination as to whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message as generally set forth in independent claim 21. Thus, Akahane and Parvulescu, either alone or in combination, fail to render independent claim 21 obvious.

As also indicated above, neither Ayoub nor Parvulescu, alone or in combination, teaches or suggests a determination as to whether the intended recipient is capable of receiving the SVMS message prior to transmission of the SVMS message as generally set forth in independent claim 20. Thus, Ayoub and Parvulescu, either alone or in combination, fail to render independent claim 21 obvious.

Accordingly, for the reasons provided above, the Applicant respectfully submits that the rejections of independent claims 20 and 21 should be reversed.